APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,708	09/21/1999	MICHAEL L. GOUGH	NEO1P018	3709

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 September 2002</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
             application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> .	6) ☐ Other: .

1.   This office action is in response to Amendment filed 9/03/02. Amended claims

1,15,16 and new claims 17-22 are pending. The rejection is cited as stated below.

2.   Applicant's amendments filed 9/03/02 have been fully considered by modifying

the claims language: per claim 1, initializing at least one application program after a first

electronic message is selected by a first user, wherein the application program is

received, at least in part, over the network after the receipt of the first electronic

message and as the result of the selection by the first user, of the electronic message.

Examiner notes the previous prior art does not contain these limitations. However these

limitations have been taught by the new prior art (i.e.: Suarez, Skladman).Therefore it

moots to new ground of rejection wherein the rejection bases on the new prior art with

the equivalent limitations as the invention claimed.

        Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention (i.e.: the first electronic message, the first user, etc. It is not

clear what different between the first and second message, second user)

        Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. (i.e.: Claim 15 discloses a first code segment and second

code segment which different to claims 1 and 16. Examiner assumes the first and

second code segment is belonged to the application program in claims 1 and 16 as the

same invention).

3.   Claims 1-22 are rejected under 35 U.S.C. § 102[b] as being anticipated by

Suarez et al [Suarez 5,790,789]

4.   As per claims 1,15,16 Suarez discloses the invention substantially as claimed,

including a method for executing an application program associated with an electronic

message [abstract], comprising:

       after a first electronic message is selected by a first user, initializing at least one

application program, wherein the application program is received, at least in part, over

the network after the receipt of the first electronic message and as the result of the

selection by the first user, of the electronic message which is equivalent to a user

defined/selected agent, host, queues, certain aspects of the message, etc. [Suarez col

15 lines 35-65, col 17 lines 4-16] upon received a receipt of a electronic message

[Suarez col 6 lines 12-30, col 28 lines 20-47, col 31 lines 9-36, 60-col 32 line 17];

       automatically executing the application program of the first electronic message

after the initialization thereof which is equivalent to the receive request to invoke an

intelligent agent [Suarez Fig 16, col 29 lines 17-40] or the process for starting a

workflow after receive the receipt of request [Suarez col 31 lines 60-col 32 line 18].

5.   As per claim 2, Suarez discloses the first electronic message is selected by the

first user by clicking thereon as inherent feature of Email service [Suarez col 15 lines

50-65, col 16 lines 10-35].

6.   As per claims 3,14,20 Suarez discloses the application program includes an

applet (i.e.: java applet or C programming as equivalent) [Suarez col 30 lines 4-44].

7.   As per claim 4, Suarez discloses the execution of the application program

includes retrieving code from a server [Suarez col 2 lines 5-12].

8.   As per claim 5, Suarez discloses the execution of the application program

includes a functionality based on the text included with the first electronic message

[Suarez col 14 lines 20-36].

9.   As per claim 6, Suarez discloses the execution of the application program

includes streaming video such as real time behavior and programming [Suarez col 13

lines 20-37, col 28 lines 48-62] using a stream of data [Suarez col 33 lines 11].

10.   As per claim 7, Suarez discloses the execution of the application program

includes outputting an advertisement as inherent feature of application program.

11.   As per claims 8,19 Suarez discloses the application program is executed on a

network browser, or at least in part, in a browser software as inherent feature of client-

server application in WAN.

12.   As per claim 9, Suarez discloses the first electronic message is selected on an

electronic mail browser or Email service [Suarez col 15 lines 50-65, col 16 lines 10-35].

13.   As per claim 10, Suarez discloses the execution of the application program

includes automatically linking to a site on the network upon selection of the indicia such

as application host, application name, server name [Suarez col 16 lines 10-36].

14.   As per claim 11, Suarez discloses the execution of the application program

includes retrieving an email server address from a computer of the first user for sending

the entered text and the application program over the network in the second electronic

message as inherent feature of the execution of the application program such as Java

applet, C programming.

15.   As per claim 12, Suarez discloses the entered text includes an electronic mail

address of the second user which is equivalent to edit the message or customized

services [Suarez col 29 line 60-col 30 line 3].

16.   As per claim 13, Suarez discloses the application program includes markup

language which calls an object-oriented computer language as inherent feature of the

application program [Suarez col 5 line 59-col 6 line 10].

17.   As per claims 17,18,21,22 Suarez discloses the application develops at least one

of pictorial, graphic, animated, video and audio display as inherent feature of real time

programming [Suarez col 13 lines 20-37, col 28 lines 48-62].

18.   Claims 1-22 are rejected under 35 U.S.C. § 102[e] as being anticipated by

Skladman et al [Skladman 6,400,810 B1]

19.   As per claims 1,15,16 Skladman discloses the invention substantially as claimed,

including a method for executing an application program associated with an electronic

message [abstract]

       after a first electronic message is selected by a first user, initializing at least one

application program, wherein the application program is received, at least in part, over

the network after the receipt of the first electronic message and as the result of the

selection by the first user, of the electronic message which is equivalent to a subscriber

received a notification, subscriber populates fitler lists (i.e.: select a filter), a software

program generates a menu [Skladman col 2 lines 22-col 3 line 57] ;

automatically executing the application program of the first electronic message

after the initialization thereof which is equivalent to a software program generates a

menu by using the filter list [col 3 lines 47-57].

Thus, the system and method of claims 1,15,16 is obvious in view of the

combination of the references.

20.   As per claim 2, Skladman discloses the first electronic message is selected by

the first user by clicking thereon as inherent feature of Email service.

21.   As per claims 3,14,20 Skladman discloses the application program includes an

applet as inherent feature of software program [col 4 lines 12-19].

22.   As per claim 4, Skladman discloses the execution of the application program

includes retrieving code from a server as inherent feature of software program [col 4

lines 12-19].

23.   As per claim 5, Skladman discloses the execution of the application program

includes a functionality based on the text included with the first electronic message as

inherent feature of software program [col 4 lines 12-19].

24.   As per claim 6, Skladman discloses the execution of the application program

includes streaming video as inherent feature of software program [col 4 lines 12-19].

25.   As per claim 7, Skladman discloses the execution of the application program

includes outputting an advertisement as inherent feature of software program [col 4

lines 12-19].

26.   As per claims 8,19 Suarez discloses the application program is executed on a

network browser, or at least in part, in a browser software as inherent feature of

software program [col 4 lines 12-19].

27.   As per claim 9, Skladman discloses the first electronic message is selected on an

electronic mail browser or Email service.

28.   As per claim 10, Skladman discloses the execution of the application program

includes automatically linking to a site on the network upon selection of the indicia as

inherent feature of software program [col 4 lines 12-19]

29.   As per claim 11, Skladman discloses the execution of the application program

includes retrieving an email server address from a computer of the first user for sending

the entered text and the application program over the network in the second electronic

message as inherent feature of software program [col 4 lines 12-19]

30.   As per claim 12, Skladman discloses the entered text includes an electronic mail

address of the second user which is equivalent to edit the message or customized

services [Fig 5-6].

31.   As per claim 13, Skladman discloses the application program includes markup

language which calls an object-oriented computer language as inherent feature of

software program [col 4 lines 12-19]

32.   As per claims 17,18,21,22 Skladman discloses the application develops at least

one of pictorial, graphic, animated, video and audio display as inherent feature of

software program [col 4 lines 12-19].

Thus, as explained above, the system and method of claims 1-22 is anticipated

by the prior art.

33.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Mark Rinehart*, can be reached at (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

> After Final   (703) 746-7238
> Official: (703) 746-7239
> Non-Official   (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu
Patent Examiner
Art Unit 2142

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